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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,836	04/17/2004	Wade C. Horton	HORTON-PA-1	8772

7590 05/02/2006

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EXAMINER

DEVOTI, PAUL D

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/825,836	<b>Applicant(s)</b> HORTON, WADE C.	
	<b>Examiner</b> Paul Devoti	<b>Art Unit</b> 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 8 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/17/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species:

- a. Species 1- Figures 1, 2
- b. Species 2- Figures 3A, 3B, 3C

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-6, 9-11, and 12 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

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2. During a telephone conversation with Mr. Royal Craig on April 21, 2006 a provisional election was made without traverse to prosecute the invention of Species 1. Affirmation of this election must be made by applicant in replying to this Office action. Claim 8 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the recessed lighting fixture of claim 7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 7, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 recites the limitation "finishing ring" in lines 4, and 7-8. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 1 recites the limitation "covering plate" in line 4. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 13 recites the limitation "the finishing ring" in line 2. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 13 recites the limitation "covering plate" in line 2. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 1 recites the phrase "conventional trim ring" in line 2, which renders the claim indefinite, as there are many possible types of trim rings available and no one would know what is "conventional".

11. Claim 1 recites the phrase "trim ring" in lines 2 and 6, and the phrase "the finishing ring" in line 4 and 7. Additionally, the applicant recites "a finishing ring" in claim 7, lines 2 and 3. The examiner is unsure whether the "trim ring" and the "finishing ring" are referring to the same item, or if they are different parts.

12. Regarding claim 1, line 1 ("An accent frame for framing an article inset within a cutout of a structure...") recites the article as intended use. Claim 7, lines 1-3 ("...wherein said article is a recessed lighting fixture with a finishing ring attached to the recessed lighting fixture by expandable tension clips and slots and wherein said frame is secured in place between the structure and said attached finishing ring"), however, recite the article positively. It is unclear whether claims 1 and 7 are directed towards an accent frame per se, or a combination of an accent frame and a recessed lighting fixture. For the purposes of examination, the examiner is considering the subcombination of the accent frame, and any recitation of a combination of an accent frame and a recessed lighting fixture will not be given any patentable weight.

### ***Claim Objections***

13. Claim 12 is objected to because it includes a reference character, "6", which is not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1, 2, 3, 4, 5, 7, 9, 10, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lackey (US 5975853).

16. Regarding claims 1, 9, and 10, Lackey discloses an accent frame in the form of a rigid, plastic cover, which serves as an aesthetically pleasing backdrop. It is inherently capable of framing an article within a cutout of a structure. The cover has an aperture (31) corresponding in size to a cutout (A) in a ceiling (C). The cover (10) is secured in place against the ceiling (C) by a covering plate (P), as seen in Figure 5.

17. Regarding claims 2 and 5, the cover (10) comprises a decorative outer edge (as seen in Figure 1) as in the shape of a circular object.

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18. Regarding claims 3 and 4, the cover (10) is seated flush with the ceiling (C) and flares away to provide aesthetically pleasing depth and texture.

19. Regarding claim 13, the cover (10) is decorative with ornamentation (O) and is inherently capable of covering any imperfections in the edges of the cutout not covered by the covering plate (P).

20. Regarding claim 7, the recessed lighting fixture with tension clips and slots is an intended use, and the cover (10) is inherently capable of framing a recessed lighting fixture that is within a cutout of a structure.

### ***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lackey (US 5975853).

23. Regarding claim 6, Lackey discloses everything previously mentioned, but does not disclose the cover is approximately 1 mm thick. It would have been an obvious matter of design choice to make the cover approximately 1 mm thick, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.



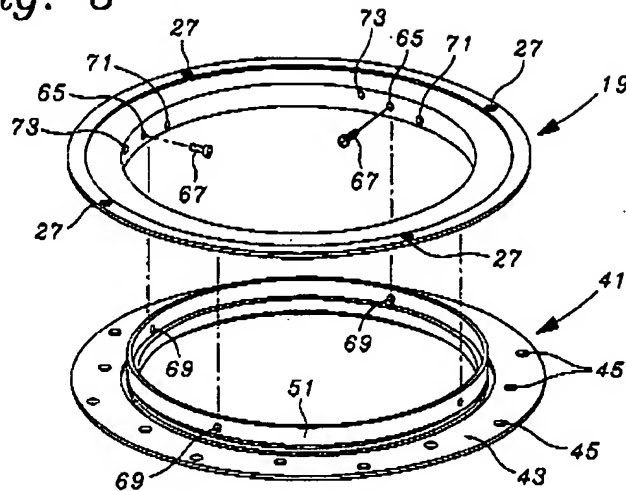
24. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lackey (US 5975853) in view of Gretz (US 6152413).

25. Regarding claim 11, Lackey discloses everything previously mentioned, but does not disclose the cover is formed by injection molding. Gretz, however, discloses a mounting block with a medallion portion that is plastic and formed from injection molding (column 4, lines 56-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify Lackey's cover to be formed from injection molding, as taught by Gretz to have high strength and be integrally formed.

26. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lackey (US 5975853) in view of Kelmelis et al. (US 6474846).

27. Regarding claim 12, Lackey discloses everything previously mentioned, but does not disclose the cover is comprised of a lip extending from the aperture (31) toward the cutout (A) to serve as a guide for positioning. Kelmelis, however, discloses a lighting system with a framing member (41) that has a lip (51) extending from an aperture that serves as a guide for positioning. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify Lackey's cover to include a lip extending from the aperture, as taught by Kelmelis to guide the framing member in position.

*Fig. 3*



Kelmelis (US 6474846) Figure 3

### **Conclusion**

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burgess (US 2004/0177572) discloses an aperture edging member, with an upwardly projecting lip, capable of framing an aperture in a wall or ceiling. Snead (US D490930) discloses a drywall finish piece for recessed lights. Taylor, III (US 5349513) discloses a light fixture with a decorative frame member and a covering plate for an aperture in a ceiling. Gretz (US 5939671) discloses a ceiling medallion assembly for securing an electrical device. MacLeod et al. (US 5000409) discloses a wall mounting bracket with a decorative frame and a mounting plate.

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29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Devoti whose telephone number is 571-272-2733.

The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PD *7D*  
04/28/06

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